



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,050	07/15/2003	Merritt W. Dixon III	590062-2006.4	7647

7590                    03/09/2004  
FROMMER LAWRENCE & HAUG LLP  
745 FIFTH AVENUE  
NEW YORK, NY 10151

EXAMINER	
HENDERSON, MARK T	
ART UNIT	PAPER NUMBER
3722	

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/620,050	DIXON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Mark T Henderson	3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                                        |                                                                             |
|----------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                   | Paper No(s)/Mail Date. _____.                                               |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|                                                                                                                                        | 6) <input type="checkbox"/> Other: _____.                                   |

**DETAILED ACTION**

**Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 21-35 have been canceled.

***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 9-17, and 21-28 of U.S. Patent No. 6,328,339. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the patent ('339) and the applicant's claims disclose a coupon booklet comprising a front cover, a back cover, a

number of pages; a listing arranged alphabetically in a color-coded index form according to food or products groups; a single bar code, a table of contents; wherein the listing indicates a credit for each item which is receivable upon purchase; and wherein one of the accounts is a saving accounts, a vacation savings account, tuition savings, or an interest-bearing account. Claim 1 of the Patent has further limitations to the bar code not required by the claims in the application. Since applicant has received a patent for a specific embodiment, the applicant is not entitled to a patent for a broader invention (see *In re Goodman*).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 1-3, 5 and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Olson (5,249,827).

Olson discloses in Fig. 1-7, a coupon booklet comprising: a front cover and a back cover (as shown in Fig. 1 and 2) and a number of pages (33); wherein the pages and covers are coupled together at a common edge (42 in Fig. 9) to be openable and

closeable in a book-like manner; a listing and/or a table of contents (34) of any particular group arranged in a color coded (Col. 9, lines 59-65 and Col. 21, lines 38-41) index form and having a miniature picture (Fig. 3) of a plurality of items (35) and a single bar code (65) identifying the items.

In regards to **Claims 18 and 19**, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Therefore, the color-coded index form in the Olson reference is capable of being in accordance with a type, or a food or product group of the plurality of items.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4 and 6-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olson.

Olson discloses all the elements as claimed in Claim 1, and as set forth above.

However, Olson does not disclose: a listing arranged in index form alphabetically according to food or product groups; wherein each group includes sub-headings subdivided by items; an indicator of a respective group is adjacent to the group; wherein the index group includes having the items arranged according to prices, manufacturers; wherein the listing indicates a credit for each item which is receivable upon purchase; wherein the credit is applied to either a savings account, holiday account, vacation account, tuition account, or an interest-bearing account; and wherein the index form is color coded according to a food or product group.

In regards to **Claim 4**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the listing in any desirable arrangement, since it has been held that rearranging parts of an invention involves only routine skill in the art, since the particular arrangement set forth has no asserted criticality and the arrangement taught by Olsen would work equally as well.

In regards to **Claims 6-16**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any type of indicia on the index form, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401,

(CAFC 1983). Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of listing does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. As a result, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability. Therefore, it would have been obvious to one having ordinary skill in the art to provide a group having arranged sub-headings indicia, as necessitated by the end user.

#### ***Prior Art References***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Dixon, III et al further discloses a coupon booklet.

### Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

March 7, 2004



A. L. WELLINGTON  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700